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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,241	07/29/2003	Frederick Bleckmann	724917-53620	4751

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EXAMINER

SELLS, JAMES D

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/628,241

Applicant(s)

BLECKMANN ET AL.

Examiner

James Sells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 7, 25, 27, 34-35, 41-44 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Zurmuhr et al (DE 26 24 055)

Zurmuhr discloses a method and apparatus for producing labels. As shown in Fig. 3, the system comprises roll 4' of strip material 3 which is fed to folding station 8. Folding station 8 folds the strip along the centerline and heated press 31 presses the folded strip. Next the strip travels through perforator 12, past photocell 14 of scanning station 9, and feed system 10 before individual labels are cut at heat-cutting station 15.

Although not explicitly stated in the reference of Zurmuhr, it is the examiner's position that the heated press 31 inherently sets the fold in the strip in the manner claimed by the applicant.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zurmuhrr et al as described above in view of Dolling et al (US Patent 5,932,041).

Dolling discloses a method and apparatus for ultrasonically cutting sheets and textile webs. As shown in Figs. 1-2, the system comprises ultrasonic sonotrode 5 that cooperates with separator anvil wheel 3 to cut web 1. It would have been obvious to one having ordinary skill in the art to substitute an ultrasonic cutter, as taught by Dolling, for the heat-cutter in the method and apparatus of Zurmuhrr as a matter of design choice because ultrasonic cutters and heat cutters are functionally equivalent alternate expedients.

5. Claims 3-4, 8-9, 28-32 36-40 and 45-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zurmuhrr et al as described above in view of Clare (US Patent 5,745, 036)

Clare discloses an electronic article security system in which security tags 22 are attached to articles 12. These tags 22 include a radio frequency circuit 24 and may be incorporated into the articles at the point of manufacture (see col. 4, lines 15-39). It would have been obvious to one having ordinary skill in the art to employ an RF security circuit, as taught by Clare, in the labels or tags of Zurmuhrr in order to provide increased security for the articles to which the labels are attached.

It is the examiner's position that without the disclosure of unexpected results, the specific conveyor system, indexing system, cutting and folding systems for making the

various types of folds are conventional in the art and would have been obvious to one having ordinary skill in the art to employ as a matter of design choice.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 10-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,432,235. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations of applicant's claims 10-24 are contained within or made obvious by claims 1-17 of U.S. Patent No. 6,432,235.

8. Claims 1-46 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45 of U.S. Patent No. 6,780,265. Although the conflicting claims are not identical, they are not patentably

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distinct from each other because all the limitations of applicant's claims 1-46 are contained within or made obvious by claims 1-45 of U.S. Patent No. 6,780,265.

9. Claims 1-46 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 6-63 of copending Application No. 10/816,043. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations of the present claims are contained within or made obvious by claims 1-4 and 6-63 of copending Application No. 10/816,043.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

10. Claims 13, 29 and 37 contain the trademark/trade name Manhattan fold. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe

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a specific type of fold configuration and, accordingly, the identification/description is indefinite.

Claim Objections

11. Claims 6, 19 and 33 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n).

Telephone/Fax

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sells whose telephone number is (571) 272-1237. The examiner can normally be reached on Monday-Friday between 9:30 AM and 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached at (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.



**JAMES SELLS
PRIMARY EXAMINER
TECH. CENTER 1700**